

REMARKS

I. Introduction

Claims 17 to 32 are pending in the present application. In view of the following remarks, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

It is noted that the Office Action Summary does not include an acknowledgment of the claim for foreign priority and does not indicate receipt of a certified copy of the priority document. In this regard, a claim of priority to Application No. 103 44 624.9, filed in the Federal Republic of Germany on September 25, 2003 was made, inter alia, in the "Combined Declaration and Power of Attorney for Patent Application," submitted in the present application on March 27, 2006. At least the "Notice of Acceptance of Application Under 35 U.S.C. 371 and 37 CFR 1.495," dated September 26, 2006, indicates that the Office has received a certified copy of the priority document. It is respectfully requested that the Examiner acknowledge the claim for foreign priority and acknowledge receipt of the certified copy of the priority document in the next Office communication.

II. Rejection of Claims 17 to 32 Under 35 U.S.C. § 112, First Paragraph

Claims 17 to 32 were rejected under 35 U.S.C. § 112, first paragraph, as to the enablement requirement.

The Office Action states that "[r]egarding claim 17, the limitation 'the at least one first support surface and the at least one second support surface have a lateral clearance from each other' and 'the at least one first elastic element bridges the lateral clearance in the form of a first free bridge' is not understood by an ordinary skill in the art [sic]." (Office Action, p. 2). In this regard, the Office Action further states that "[a]s best understood by the Examiner and shown in Fig. 3, the first support surface 30 is the surface of the overlapping region of the holding tab 17 and elastic member and the second support surface 31 is the overlapping region of the pocket side wall 8' and the elastic member. However, as shown in Fig. 2, there is no lateral clearance between first support surface 30 and the at least one second support surface 31 and the disclosure does not show how the lateral clearance 32 is formed in Fig. 3." (Office Action, p. 3).

The present rejection is not based upon the proper standard for determining compliance with the enablement requirement of 35 U.S.C. § 112, first

paragraph. Rather, it appears that the present rejection reflects an apparent misapprehension between the distinct concepts of enablement, under 35 U.S.C. § 112, first paragraph, and definiteness, under 35 U.S.C. § 112, second paragraph. An analysis for compliance with the written description requirement requires a determination as to whether the application, when filed, contained sufficient information regarding the subject matter of the claims as to enable one skilled in the pertinent art to make and use the claimed subject matter without undue experimentation. U.S. v. Telectronics, Inc., 857 F.2d 778, 785, 8 U.S.P.Q.2d 1217, 1223 (Fed. Cir. 1988) (“The test of enablement is whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation.”). Among the factors that **must** be considered in an analysis for compliance with the enablement requirement are: (1) the breadth of the claims; (2) the nature of the invention; (3) the state of the prior art; (4) the level of one of ordinary skill in the art; (5) the level of predictability in the art; (6) the amount of direction provided by the inventor; (7) the existence of working examples; and (8) the quantity of experimentation needed to make or use the invention based on the content of the disclosure. In re Wands, 858 F.2d 731, 737, 8 U.S.P.Q.2d 1400, 1404 (Fed. Cir. 1988). It is, however, improper to conclude that a disclosure is not enabling based on an analysis of only one of these factors while ignoring one or more of the other factors. That is, a proper analysis must consider all the evidence related to each of these factors. Rather than addressing any of these factors, the Office Action contends that certain phrases included in claim 17 are “not understood by an ordinary skill in the art [sic].” As such, the present rejection is plainly deficient with regard to the proper showing required to establish that the enablement requirement is not satisfied.

Accordingly, it is respectfully submitted that the Office Action plainly fails to establish that claims 17 to 32 do not comply with the enablement requirement.

It is therefore respectfully requested that the rejection be withdrawn.

III. Conclusion

It is therefore respectfully submitted that all of the presently pending claims are allowable. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is earnestly solicited.

Respectfully submitted,

Date: April 28, 2008

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